

Appln. No.: 09/479,918
Amendment dated September 29, 2003
Reply to Office Action of March 27, 2003



#10
m
11/19/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Cory E. Klatt et al.

Serial No.: 09/479,918

Filed: 01/10/2000

For: SYSTEM AND METHOD OF USING
A SALES MANAGEMENT SYSTEM
TO GENERATE PRINTED
PRODUCTS

Atty. Docket No.: 4944.85635

Group Art Unit: 3624

Examiner: Colbert, Ella

Confirmation No.: 3694

RESPONSE TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
OCT 03 2003
GROUP 3600

Sir:

The office action of March 27, 2003 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application is respectfully requested. Claims 1-32 remain pending in this application.

In the Office Action claims 1-32 were rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,563, 999 to Yaksich, hereafter ("Yaksich"), in view of U.S. Patent No. 6,330,542 to Sevcik, hereafter ("Sevcik").

Yaksich describes a method for minimizing warehousing of pre-printed paper forms for users of business forms having multiple locations of use. Forms are designed at a central location and may be stored electronically at a central library facility. Forms are distributed to specified use locations electronically or via delivery. These forms are then printed and/or stored at a use location, at a warehouse owned by a forms vendor, or at another remote location.

Sevcik, on the other hand, describes an automated internet quoting and procurement system for commercial printing. A buyer when using the system over the internet enters in certain desired printing or similar criteria for a specific print job. Previous to the buyer's entry, print providers have also submitted information that has been entered into the system. The print

provider information is reviewed and quotes based on several possible criteria are provided to the buyer for the desired printing job the buyer described and the job may be subsequently scheduled and payment submitted online.

Claim 1 recites a method comprising the steps of: "(1) monitoring the sales management system to detect a predefined sales event; (2) in response to detecting the predefined sales event in step (1), generating event data comprising information that describes the sales even; and (3) in a print processing facility, receiving the event data, comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data."

The office action specifically rejects claim 1, asserting that Yaksich teaches "(1) monitoring the sales system to detect a predefined sales event" and "(2) in response to detecting the predefined sales event in step (1), generating event data comprising information that describes the sales event." The office action also asserts that Sevcik discloses, "(3) in a printing processing facility, receiving the event data comparing the event data to one or more predefined event rules that determine whether the printed product should be produced and, in response to a positive determination, automatically generating a print order for the printed product using information extracted from the event data."

Yaksich does not teach either the "monitoring" or the "generating" elements of claim 1 as asserted by the Examiner. In Yaksich, no "monitoring" is done of a "sales system to detect a predefined sales events." Instead, forms that have been stored at a CLF (central library facility), are downloaded to users on a previously specified release date. (See col 1:58-61; col 2:32-37) A user entered request or instruction causes forms to be sent and/or printed and no monitoring is done. Further, Yaksich does not teach or suggest a "sales system." Neither the CLF nor the FAP (forms automation platform) are a sales system or part of a sales system. These are simply components used for storage and distribution of business forms. Since there is no "sales system," no "sales event" is present in Yaksich either.

Yaksich does not teach or suggest any detection of a "predefined sales event." Yaksich teaches user specification of a release date for the forms to users. No detection of the occurrence

of a sales event is described, nor is generation of any "event data comprising information that describes the sales event."

The Examiner notes that Yaksich fails to teach or suggest element 3 and uses Sevcik to account for the deficiencies of Yaksich. Sevcik does not teach the third element of the claim as asserted in the office action. Sevcik does not teach a "printing processing facility" and thus no "receiving" etc. can take place therewithin. Sevcik teaches a method of providing a connection between "buyers" and "print providers" that allows buyers to make job requests and quotes to be displayed for a buyer to review. (See col 2: 43-50) No "print processing facility" is described and once a buyer accepts a quote and makes payment and/or authorization for the print job to occur, job is performed. Formulation of the quotes based on the buyer and previous is done in a computer per algorithms. (See col 3: 55-61) Subsequent buyer selection, acceptance and payment is required for the printing to eventually be performed.

In addition to the above, Applicants respectfully submit that the Office Action does not establish a prima facie case of obviousness. To establish a prima facie case of obviousness, there must be some suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the referenced teachings to form the claimed invention. *See* MPEP § 706.02(j). In addition, there must be a reasonable expectation of success, and the combined prior art references must teach or suggest all the claim limitations. *See Id.*

The office action rejects claims 2-16 under 35 USC §103(a) as being obvious based upon Yaksich in view of Sevcik. These dependent claims, which depend upon claim 1 are patentably distinct over the prior art of record for at least the same reason as the ultimate base claim and further in view of the their novel features recited therein.

The office action rejects claim 17 based upon Yaksich in view of Sevcik. For substantially the same reasons as claim 1 the cited art alone or in combination fails to disclose the elements of claim 17. Additionally, similar to claim 1, the office action fails to establish a prima facie case of obviousness, for among other things there is no suggestion or motivation to combine.

The office action rejects claims 18-30 under 35 USC §103(a) as being obvious based upon Yaksich in view of Sevcik. These dependent claims, which depend upon claim 17 are patentably distinct over the prior art of record for at least the same reason as the ultimate base claim and further in view of the their novel features recited therein.

The office action rejects claim 31 based upon Yaksich in view of Sevcik. For substantially the same reasons as claim 1 and 17 the cited art alone or in combination fail to disclose the elements of claim 31. Additionally, similar to claim 1 and 17, the office action fails to establish a prima facie case of obviousness, for among other things there is no suggestion or motivation to combine.

The office action rejects claim 32 under 35 USC §103(a) as being obvious based upon Yaksich in view of Sevcik. These dependent claims, which depends upon claim 31 is patentably distinct over the prior art of record for at least the same reason as the ultimate base claim and further in view of the their novel features recited therein.

The Commissioner is authorized to debit or credit our Deposit Account No. 19-0733 for the extension of time for this response and any additional necessary fees.

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: September 29, 2003

By:



Christopher R. Glembocki
Registration No. 38,800

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001
CRG/DRG/lls